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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEE, BRYAN Y

ART UNIT

PAPER NUMBER

2445

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,867	<b>Applicant(s)</b> IZUMI, MICHIIRO	
	<b>Examiner</b> BRYAN LEE	<b>Art Unit</b> 2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,10-13 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10-13 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Response to Remarks/Arguments***

1. This communication is considered fully responsive to the Amendment filed on June 10, 2010.

2. Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is the combination of the cited prior art that discloses the presently claimed subject matter.

For instance, applicant argues that the reference *Tamura* fails to disclose SIP. However, it is the combination with *Boire-Lavigne* that discloses SIP. Next Applicant argues that *Boire-Lavigne* discloses a facsimile protocol but not a file transferring protocol independent of SIP. However, applicant fails to distinguish the present claims from the combination including *Tamura's* FTP, HTTP and SMTP protocols which are file transfer protocols independent of facsimile.

Please see below for detailed rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim(s) 1, 7 and 13** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,961,137 B1 to *Tamura et al.* ("*Tamura*") in view of U.S. Pre-Grant Publication 2003/0164986 A1 to *Boire-Lavigne et al.* ("*Boire-Lavigne*") and in view of "Next-Generation VoIP Network Architecture" to *Drew et al.* ("*Drew*").

As to **claim 1**, *Tamura* disclose(s) a communication apparatus which includes IP (Internet Protocol) communication means and transmits/receives communication data to/from a destination station discriminated by a telephone number, comprising:

*Tamura* do(es) not expressly disclose an IP address obtaining means for obtaining an IP address of the destination station from an SIP (Session Initiation Protocol) proxy server based on the telephone number of the destination station;

*Boire-Lavigne* disclose(s) determining an IP address via a SIP proxy from a telephone number. (*Boire-Lavigne*; [0045] Proxy/registrar provides IP given telephone number)

*Tamura* and *Boire-Lavigne* are analogous art because they are from the same field of endeavor with respect to transmitting faxes over the Internet.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the IP address obtaining means of *Boire-Lavigne* with the apparatus of *Tamura*. The suggestion/motivation would have

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been to determine the destination address for an Internet fax. (*Boire-Lavigne* [0045])

facsimile communication means for performing facsimile communication to/from the destination station; (*Tamura* Fig. 1 FX; PSTN discloses line switching network; See col. 2, ll. 10-32 fax device has both PSTN and Internet capability and col. 4, ll. 20-45)

*Tamura* do(es) not expressly disclose a converting means for converting a signal received/transmitted from/to said facsimile communication means without via a line switching network into VoIP (Voice over Internet Protocol) data on an IP network;

*Drew* disclose(s) substituting a VoIP network for a PSTN network.

*Drew* and *Tamura* are analogous art because they are from the same field of endeavor with respect to telecommunications over an IP network.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to replace the PSTN network of *Tamura* with the VoIP network of *Drew*. The suggestion/motivation would have been to reduce the cost of the network. (p. 19) VoIP is a replacement for traditional circuit switched, i.e. PSTN networks.

*Boire-Lavigne* further disclose(s) a gateway for encoding fax communication into for VOIP network. (*Boire-Lavigne*; [0032] VOIP gateway is equipped with codec to encode fax communications)

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At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the encoding gateway of *Boire-Lavigne* with the apparatus of *Tamura*. The suggestion/motivation would have been to format the fax in a format compatible with the communication devices. (*Boire-Lavigne*; [0012])

IP network connecting means for connecting to the IP network; and (*Tamura* Fig. 1 FX; LAN discloses IP network; See col. 2, ll. 10-32 fax device has both PSTN and Internet capability and col. 4, ll. 20-45)

control means for controlling to,

if the destination station is able to transmit/receive communication data on the IP network based on a predetermined file transmit/receive protocol independent of a facsimile protocol, start to transmit/receive image data to/from the destination station based on the predetermined file transmit/receive protocol independent of a facsimile protocol, via the IP network connecting means without via a lien switching network, using the obtained IP address of the destination station, in response to the acquirement of the IP address by said IP address obtaining means, and (*Tamura* discloses transferring a fax based on IP networks using FTP, HTTP, and SMTP; See columns 6-8; but if no Internet fax capability present to use a PSTN capability; See col. 9, ll. 42-52; The FTP, HTTP, and SMTP protocols are all file transferring protocols that are independent of facsimile protocols.)

if said destination station is not able to transmit/receive communication data on the IP network based on the predetermined file transmit/receive protocol independent of a facsimile protocol, cause said facsimile communication means to start transmission/reception of image data to/from the destination station causing said converting means to execute conversion of the signal that said facsimile communication means transmits/receives to the VoIP data to transmit/receive without via a lien switching network thus converted signal to/from the destination station via said IP network connecting means, in response to the acquirement of the IP address of the destination station by said IP address obtaining means.

*Tamura* do(es) not expressly disclose transmitting fax communications via VOIP data if FTP or HTTP capabilities are not available. *Tamura* discloses using PSTN as a fall back for fax communications.

*Boire-Lavigne* disclose(s) transmitting Fax data via a VOIP network.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to replace the VOIP aspect of *Boire-Lavigne* with the PSTN fall back of *Tamura*. The suggestion/motivation would have been to format the fax in a format compatible with the communication devices. (*Boire-Lavigne*; [0012]) (Additionally see *Drew* p. 16 -- if VoIP Fax is not be supported, providing an alternate mechanism of transmission is desirable)

As to **claim 7**, *Tamura* and *Boire-Lavigne* disclose(s) a control method executed in a communication apparatus which includes an IP (Internet Protocol)

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communication means and transmits/receives communication data to/from a destination station discriminated by a telephone number, an IP address obtaining means for obtaining an IP address of the destination station from an SIP (Session Initiation Protocol) proxy server based on the telephone number of the destination station, a facsimile communication means for performing a facsimile communication to/from the destination station, a converting means for converting a signal received/transmitted from/to said facsimile communication means without via a lien switching network into VoIP (Voice over Internet Protocol) data on the IP network, an IP connecting means for connecting to the IP network, and a control unit, the method comprising:

if the destination station is able to transmit/receive communication data on the IP network based on a predetermined file transmit/receive protocol independent of a facsimile protocol, the control unit controlling to start to transmit/receive image data to/from the destination station based on the predetermined file transmit/receive protocol independent of a facsimile protocol without via a lien switching network using the obtained IP address of the destination station, in response to the acquirement of the IP address by the IP address obtaining- means, and

if the destination station is not able to transmit/receive communication data on the IP network based on the first predetermined file transmit/receive protocol independent of a facsimile protocol, the control unit controlling to cause said facsimile communication means to start transmission/reception of image



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data to/from the destination station and causing said converting means to execute conversion of the signal that said facsimile communication means transmits/receives to the VoIP data to transmit/receive thus converted signal to/from the destination station via the IP network connecting means without via a lien switching network, in response to the acquirement of the IP address of the destination station by said IP address obtaining means.

See similar rejection and motivation to claim 1, where the method is taught by the apparatus of 1.

As to **claim 13**, *Tamura and Boire-Lavigne* disclose(s) a computer-readable storage medium on which is stored computer code for a control program for a communication apparatus which includes an IP (Internet Protocol) communication means and transmits/receives communication data to/from a destination station discriminated by a telephone number, an IP address obtaining means for obtaining an IP address of the destination station from an SIP (Session Initiation Protocol) proxy server based on the telephone number of the destination station, a facsimile communication means for performing a facsimile communication to/from the destination station, a converting means for converting a signal received/transmitted from/to said facsimile communication means without via a lien switching network into VoIP (Voice over Internet Protocol) data on the IP network, an IP connecting means for connecting to an IP network, and a control unit, the program comprising:

if the destination station is able to transmit/receive communication data on the IP network based on a predetermined file transmit/receive protocol independent of a facsimile protocol, the control means controls to start to transmit/receive image data to/from the destination station based on the predetermined file transmit/receive protocol independent of a facsimile protocol without via a lien switching network using the obtained IP address of the destination station, in response to the acquirement of the IP address by the IP address obtaining means, and

if the destination station is not able to transmit/receive communication data on the IP network based on the predetermined file transmit/receive protocol independent of a facsimile protocol, the control means controls said facsimile communication means to start transmission/reception of image data to/from the destination station, and causes said converting means execute conversion of the signal that is transmitted/received to the VoIP data to transmit/receive without via a lien switching network thus converted signal to/from the destination station via the IP network connecting means, in response to the acquirement of the IP address of the destination station by said IP address obtaining means.

See similar rejection and motivation to claim 1, where the medium is taught by the apparatus of 1.

5. **Claim(s) 4, 10 and 16** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,961,137 B1 to *Tamura et al.* ("*Tamura*") in view of U.S. Pre-Grant Publication 2003/0164986 A1 to *Boire-Lavigne et al.* ("*Boire-Lavigne*") in

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view of "Next-Generation VoIP Network Architecture" to *Drew et al.* ("*Drew*") and in further view of U.S. Pre-Grant Publication 2003/0026400 A1 to *Bashoura et al.* ("*Bashoura*").

As to **claim 4**, *Tamura* does not expressly disclose a communication apparatus,

wherein said IP address obtaining means judges, by analyzing the telephone number of the destination station, whether or not the obtaining means is able to perform the communication with the destination station via a VoIP (Voice over Internet Protocol) network, and tries to obtain the IP address of the destination station from a predetermined server when it is able to perform the communication via the VoIP network, and said control means transmits/receives the communication data to/from the destination station on the IP network based on the predetermined file transmit/receive protocol independent of a facsimile protocol by using the obtained IP address of the destination station.

*Bashoura* disclose(s) storing IP addresses associated with telephone numbers in a telephone table. (*Bashoura*; IP lookup table from Telephone number; [0046])

*Tamura* and *Bashoura* are analogous art because they are from the same field of endeavor with respect to faxing over the Internet.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the telephone table of *Bashoura* with the

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apparatus of *Tamura*. The suggestion/motivation would have been to determine if an IP address exists for a destination device. (*Boire-Lavigne* [0016])

As to **claim 10**, *Bashoura* disclose(s) a control method, wherein the IP address obtaining means judges, by analyzing the telephone number of the destination station, whether or not the obtaining means is able to perform the communication with the destination station via a VoIP network, and tries to obtain the IP address of the destination station from a predetermined server when it is able to perform the communication via the VoIP network, and the communication data is transmitted/received to/from the destination station on the IP network based on the predetermined file transmit/receive protocol independent of a facsimile protocol by using the obtained IP address of the destination station.

See similar rejection and motivation to claim 4, where the method is taught by the apparatus of 4.

As to **claim 16**, *Bashoura* disclose(s) a computer-readable storage medium, wherein the IP address obtaining means judges, by analyzing the telephone number of the destination station, whether or not the obtaining means is able to perform the communication with the destination station via a VoIP network, and tries to obtain the IP address of the destination station from a predetermined server when it is able to perform the communication via the VoIP network, and transmitting/receiving the communication data to/from the destination station on the IP network based on the predetermined file

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transmit/receive protocol independent of a facsimile protocol by using the obtained IP address of the destination station.

See similar rejection and motivation to claim 4, where the medium is taught by the apparatus of 4.

6. **Claim(s) 5, 11 and 17** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,961,137 B1 to *Tamura et al.* ("*Tamura*") in view of U.S. Pre-Grant Publication 2003/0164986 A1 to *Boire-Lavigne et al.* ("*Boire-Lavigne*") in view of "Next-Generation VoIP Network Architecture" to *Drew et al.* ("*Drew*") in further view of U.S. Pre-Grant Publication 2002/0001302 A1 to *Pickett et al.* ("*Pickett*").

As to **claim 5**, *Tamura* does not expressly disclose(s) a communication apparatus, wherein said IP network connecting means is an ADSL (Asymmetric Digital Subscriber Line) modem.

*Pickett* disclose(s) using ADSL to connect to the IP network. (*Pickett*; [0069])

*Pickett* and *Tamura* are analogous art because they are from the same field of endeavor with respect to faxing over the Internet.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the ADSL aspect of *Pickett* with the IP network of *Tamura*. ADSL was well known to persons of ordinary skill in the art at the time of invention as a means for connecting to the Internet. The suggestion/motivation would have been to use a well know means to connect to the network. (*Pickett*; [0069])

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As to **claim 11**, *Pickett* disclose(s) a control method, wherein the IP network connecting unit is an ADSL (Asymmetric Digital Subscriber Line) modem.

See similar rejection and motivation to claim 5, where the method is taught by the apparatus of 5.

As to **claim 17**, *Pickett* disclose(s) a computer-readable storage medium, further comprising a control step of performing the transmission/reception of the communication data on the IP network and the transmission/reception of the communication data on an analog communication path by using an ADSL (Asymmetric Digital Subscriber Line) modem.

See similar rejection and motivation to claim 5, where the medium is taught by the apparatus of 5.

7. **Claim(s) 6, 12 and 18** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,961,137 B1 to *Tamura et al.* ("*Tamura*") in view of U.S. Pre-Grant Publication 2003/0164986 A1 to *Boire-Lavigne et al.* ("*Boire-Lavigne*") in view of "Next-Generation VoIP Network Architecture" to *Drew et al.* ("*Drew*") in further view of U.S. Pre-Grant Publication 2004/0001221 A1 to *McCallum et al.* ("*McCallum*").

As to **claim 6**, *Tamura* does not expressly disclose(s) a communication apparatus, wherein the IP address of the destination station is obtained from a predetermined server based on the telephone number of the destination station by using a predetermined UDP (User Datagram Protocol), and said control means controls to transmit/receive the communication data to/from the

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destination station by using the obtained IP address of the destination station, based on a predetermined TCP (Transmission Control Protocol).

*McCallum* disclose(s) using TCP and UDP to send faxes over the Internet. (*McCallum*; [0003])

*Tamura* and *McCallum* are analogous art because they are from the same field of endeavor with respect to faxing over the Internet.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the TCP and UDP aspect of *McCallum* with the network of *Tamura*. The use of TCP and UDP as part of the IP network protocol were well known to persons of ordinary skill at the time of invention. The suggestion/motivation would have been to use well known protocols for transferring faxes over the Internet. (*McCallum*; [0003])

As to **claim 12**, *McCallum* disclose(s) a control method, wherein the IP address of the destination station is obtained from a predetermined server based on the telephone number of the destination station by using a predetermined UDP (User Datagram Protocol), and the communication data is transmitted/received to/from the destination station by using the obtained IP address of the destination station, based on a predetermined TCP (Transmission Control Protocol).

See similar rejection and motivation to claim 6, where the method is taught by the apparatus of 6.

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As to **claim 18**, *McCallum* disclose(s) a computer-readable storage medium, further comprising a control steps of obtaining the IP address of the destination station from a predetermined server based on the telephone number of the destination station by using a predetermined UDP (User Datagram Protocol), and transmitting/receiving the communication data to/from the destination station by using the obtained IP address of the destination station based on a predetermined TCP (Transmission Control Protocol).

See similar rejection and motivation to claim 6, where the medium is taught by the apparatus of 6.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN LEE whose telephone number is (571)270-5606. The examiner can normally be reached on 9/4/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. L./  
Examiner, Art Unit 2445

/HASSAN PHILLIPS/  
Primary Examiner, Art Unit 2445